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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91230487
Party	Plaintiff salesforce.com, inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

SALESFORCE.COM, INC.,)	
)	
Opposer,)	Opposition No: 91230487
)	
v.)	Serial No. 86671254
)	
MCGEEVER, LLC,)	
)	
Applicant.)	
)	
)	
)	

OPPOSER’S MOTION TO CONSOLIDATE

I. INTRODUCTION

Opposer salesforce.com, inc. (“Salesforce”) hereby moves, pursuant to Federal Rule of Civil Procedure 42(a) and Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) § 511, to consolidate Opposition Nos. 91227898, 91230485, 91230486, 91230487, 91230283, and 91230507 because the proceedings involve identical parties and common questions of fact and law. In particular, the proceedings involve similar challenges to Applicant’s trademark applications for SALESFORCE4HIRE-related marks, on the one hand, and to Opposer’s trademark applications for SALESFORCE-related marks, on the other.

As set forth below, consolidating the proceedings would prevent a wasteful duplication of effort and create judicial economy for the Board. It would also avoid inconsistent decisions by the Board.

Salesforce also requests that the Board reset the dates for the discovery and trial periods in these proceedings.


II. PROCEDURAL POSTURE

The proceedings between the parties are summarized as follows:


A. Salesforce v. McGeever (“Opposition No. 91227898”)

Salesforce filed its Notice of Opposition on May 16, 2016 against the application by Applicant McGeever for the mark SALESFORCE4HIRE (Serial No. 86671414). The Notice of Opposition alleges that Salesforce owns superior rights to SALESFORCE and its FORCE Family of Marks and that the registration sought by McGeever is likely to cause confusion. McGeever filed its Answer on June 27, 2016, denying the substantive allegations in the Notice of Opposition.¹ The parties have not begun discovery.

B. Salesforce v. McGeever (“Opposition No. 91230485”)

Salesforce filed its Notice of Opposition on October 6, 2016 against McGeever’s application for the  mark (Serial No. 86671570). The Notice of Opposition alleges that Salesforce owns superior rights to SALESFORCE and its FORCE Family of Marks and that the registration sought by McGeever is likely to cause confusion. McGeever has not filed its Answer. The parties have not begun discovery.

C. Salesforce v. McGeever (“Opposition No. 91230486”)

Salesforce filed its Notice of Opposition on October 6, 2016 against McGeever’s application for the  mark (Serial No. 86671281). The Notice of Opposition alleges that (1) Salesforce owns superior rights to SALESFORCE and its FORCE Family of Marks and that the registration sought by McGeever is likely to cause confusion and (2)

¹ Opposer is separately seeking to amend its pleading to add a claim of descriptiveness and to update the status of various trademark filings.

McGeever's applied-for mark is merely descriptive and has not acquired distinctiveness.

McGeever has not filed its Answer. The parties have not begun discovery.

D. Salesforce v. McGeever (“Opposition No. 91230487”)

Salesforce filed its Notice of Opposition on October 6, 2016 against McGeever's application for the mark SALESFORCE4HIRE MG A MCGEEVER COMPANY (Serial No. 86671254). The Notice of Opposition alleges that (1) Salesforce owns superior rights to SALESFORCE and its FORCE Family of Marks and that the registration sought by McGeever is likely to cause confusion and (2) McGeever's applied-for mark is merely descriptive and has not acquired distinctiveness. McGeever has not filed its Answer. The parties have not begun discovery.

E. McGeever v. Salesforce (“Opposition No. 91230283”)

McGeever filed its Notice of Opposition on September 26, 2016 against Salesforce's application for the mark SALESFORCE (Serial No. 86639842). The Notice of Opposition alleges that McGeever owns superior rights to the mark SALESFORCE4HIRE and that the registration sought by Salesforce is likely to cause confusion. Salesforce has not filed its Answer. The parties have not begun discovery.

F. McGeever v. Salesforce (“Opposition No. 91230507”)

McGeever filed its Notice of Opposition on October 10, 2016 against Salesforce's application for the mark SALESFORCE1 LIGHTNING (Serial No. 86423963). The Notice of Opposition alleges that McGeever owns superior rights to the mark SALESFORCE4HIRE and that the registration sought by Salesforce is likely to cause confusion. Salesforce has not filed its Answer. The parties have not begun discovery.

III. DISCUSSION

The Board may consolidate multiple actions where the actions involve common questions of fact and law. Federal Rule of Civil Procedure 42(a); TBMP § 511. In determining whether to consolidate cases, the Board weighs the savings in time, effort and expense which may be gained from consolidation against any prejudice or inconvenience that consolidation could cause.

TBMP § 511.

These proceedings involve identical parties: Salesforce and McGeever.

These proceedings also involve common questions of fact and law because they each involve questions related to (1) priority of rights to SALESFORCE-related marks and SALESFORCE4HIRE-related marks, (2) likelihood of confusion, and (3) the descriptiveness of McGeever's SALESFORCE4HIRE-related marks.

As to the Section 2(d) claims, the Board will apply to each of these proceedings the same likelihood of confusion factors set forth by the Federal Circuit in *In re E.I. du Pont de Nemours & Co.*, 177 U.S.P.Q. 563 (CCPA 1973).

As to the Section 2(e) claims, the Board will apply the same analysis to determine the descriptiveness of McGeever's applied-for marks, namely, whether they "[consist] merely of words descriptive of the qualities, ingredients or characteristics of the goods or services related to the mark." *In re TriVita, Inc.*, 783 F.3d 872, 873 (Fed. Cir. 2015) (internal quotations omitted).

In sum, the evidence at trial will likely overlap in each separate proceeding given the similarity of the marks and the overlapping legal arguments by Salesforce and McGeever.

If the proceedings are not consolidated, then the parties will have to take and enter repetitive testimony and evidence in separate cases, file repetitive sets of briefs, and prepare for

separate trials on similar issues. Consequently, the Board would have to waste its efforts reviewing the same record, reading similar briefs and preparing for duplicative trials.

Furthermore, if the proceedings are not consolidated, then there is a risk of inconsistent decisions by the Board on each of the key questions cited above.

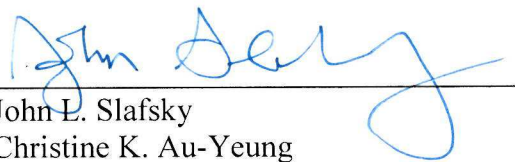
Applicant will not be prejudiced by consolidation, given the very early stage of the oppositions.

IV. CONCLUSION

For the foregoing reasons, Salesforce respectfully requests that the Board grant its motion to consolidate Opposition Nos. 91227898, 91230485, 91230486, 91230487, 91230507, and 91230283 and reset the dates for the discovery and trial periods in these proceedings.

Dated: October 17, 2016

WILSON SONSINI GOODRICH & ROSATI
Professional Corporation

By: 
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CERTIFICATE OF SERVICE BY MAIL

I, Michelle Plourde, declare:


I am employed in Santa Clara County. I am over the age of 18 years and not a party to the within action. My business address is Wilson Sonsini Goodrich & Rosati, 650 Page Mill Road, Palo Alto, California 94304-1050.

I am readily familiar with Wilson Sonsini Goodrich & Rosati's practice for collection and processing of correspondence for mailing with the United States Postal Service. In the ordinary course of business, correspondence would be deposited with the United States Postal Service on this date.

On this date, I served this **OPPOSER'S MOTION TO CONSOLIDATE** on each person listed below, by placing the document described above in an envelope addressed as indicated below, which I sealed. I placed the envelope for collection and mailing with the United States Postal Service on this day, following ordinary business practices at Wilson Sonsini Goodrich & Rosati.

Kelli Ovies
Smith Anderson Blount Dorsett Mitchell & Jemi
P.O. Box 2611
Raleigh, North Carolina 27602

I declare under penalty of perjury that the foregoing is true and correct. Executed at Palo Alto, California on October 17, 2016.


Michelle Plourde